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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------------|
| 08/551,198 | 10/31/1995 | FREDERICK S. HERZ | P0813.70006US00 | 3864 |
| 23628 7590 11/01/2007 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206 | | | EXAMINER HUYNH, BA | |
| | | | ART UNIT 2179 | PAPER NUMBER |
| | | | MAIL DATE 11/01/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/551,198

Applicant(s)

HERZ ET AL.

Examiner

Ba Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/07 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 35-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,460,036; claims 1, 3, 4, 6-11, 13, 14, 16-27 of US patent #6,088,722; claims 1-13 of US patent 6,020,883; claims 1-6, 13-18, of US patent #5,835,087; claims 1-22 of US patent 5,754,939; claim 1-36 of US patent 5,754,938. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because they all directed to personalizing user content information by generating and correlating target profile and user target profile interest summary.

The personalization of user content information by generating and correlating target profile and user target profile interest summary as currently recited in pending claims 35-47 are being obvious over the patented claims 1-20 of US patent 6,460,036 which directed to customizing electronic newspaper (target objects) by generating and correlating target profile and user target profile interest summary. It would have been obvious to one of skill in the art that the limitation customizing electronic newspaper as recited in patented claims 1-20 would have been obvious to one of skill in the art over the limitation "target objects" as broadly recited in the pending claims.

The personalization of user content information by generating and correlating target profile and user target profile interest summary as currently recited in pending claims 35-47 are being obvious over the patented claims 1, 3, 4, 6-11, 13, 14, 16-27 of US patent #6,088,722 which directed to customizing data objects (target objects) by generating and correlating target profile and user target profile interest summary.

The personalization of user content information by generating and correlating target profile and user target profile interest summary as currently recited in pending claims 35-47 are being obvious over the patented claims 1-13 of US patent 6,020,883 which directed to customizing access to data from data sources (target objects) by generating and correlating target profile and user target profile interest summary.

The personalization of user content information by generating and correlating target profile and user target profile interest summary as currently recited in pending claims 35-47 are

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being obvious over the patented claims 1-6, 13-18, of US patent #5,835,087 which directed to cataloging target objects (target objects) by generating and correlating target profile and user target profile interest summary.

The personalization of user content information by generating and correlating target profile and user target profile interest summary as currently recited in pending claims 35-47 are being obvious over the patented claims 1-22 of US patent #5,754,939 which directed to providing accesses to selected target objects (target objects) by generating and correlating target profile and user target profile interest summary.

The personalization of user content information by generating and correlating target profile and user target profile interest summary as currently recited in pending claims 35-47 are being obvious over the patented claims 1-36 of US patent #5,754,938 which directed to providing accesses to selected target objects (target objects) by generating and correlating target profile and user target profile interest summary.

Claim 35-40 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/262,123. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to providing personalizing user content information by generating and correlating target profile and user target profile interest summary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-40, 47 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #5,717,923 (Dedrick).

- As for claim 35: Dedrick teaches a method for providing a user with access to selected target objects ("electronic information") that are accessible via electronic storage media, wherein the user is connected via user terminal 12 and target server 18 which includes the electronic storage media (fig. 1), comprising the steps of:

Automatically generating target profiles (4:11-65, 8:64-9:14, 10:40-46, 13:36-41, 15:24-36) for the target objects stored in the storage media of server 18, each of the target profile being generated from the content of the target objects and their associated characteristic (8:64-9:14, 10:40-46, 13:36-41, 15:24-36), automatically generating at least a user target profile interest summary (personal profile database, 5:34-66) for a user at a user terminal, each of the user target profile interest summary being generated from target profiles associated with at least one of the electronic information accessed by the user (5:34-49, 6:53-63, 7:10-35),

enabling user access to the stored electronic information via target profile and user profile (5:20-33, 6:34-52),

correlating the user target profile interest summary with the user profile to identify electronic information (5:27-29, 6:34-36),

transmitting a list of identified target objects to the user and allowing the user to select and retrieve desired target objects (9:11-24), the list is transmitted to the user prior to user selection of the information (8:20-46).

- As for claims 36, 37, 38, 47: A list of identified target objects is transmitted to the user and allowing the user to select and retrieve desired target objects (9:11-24). Electronic information is transmitted to server 14, which is closer to the client computer (fig. 1).
- As for claim 39: The user profile includes data indicating the number of page ("screen" of information) of the retrieved document accessed by the user (8:13).
- As for claim 40: The user target profile interest summary includes the length of time the user accessed a retrieved target object (8:1-13).

Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick as applied to claim 1 above, and further in view of Cutting et al (Scatter/Gather: A cluster-based Approach to Browsing large Document Collection).

- As for claim 41: A list of identified target objects is transmitted to the user and allowing the user to select and retrieve desired target objects (9:11-24).
Dedrick fails to clearly teach sorting of the target objects based on similarity

contents, and generating a hierarchical menu identifying a content in common of target objects sorted into clusters. However in the same art of information retrieving, Cutting et al teach the method for sorting information into clusters based on similarity of its contents and presenting a hierarchical menu that identifies contents in common (page 319, "Scatter/gather browsing"; page 320, "Document Clustering"). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Cutting's clustering method to Dedrick for enabling a user to identify desirable target object. Motivation of the combining is for the advantage of being easier and more effective to retrieve information as expressly suggested by Cutting in the conclusion remarks (page 325).

- As for claim 42: The summary of the cluster is a profile having cluster attribute data to be considered by the user (page 319, col. 2, section 2). The profile is provided to each cluster produced during each successive clustering iteration (page 319, co. 2, section 2).
- As for claim 43: Target objects are divided and subdivided into multi-level hierarchy (page 319, "Scatter/Gather Browsing"; page 320, "Document Clustering").
- As for claim 44: The profile is provided to each cluster produced during each successive clustering iteration (page 319, co. 2, section 2).
- As for claim 45: Document clustering includes identifying of words (page 320, "Document Clustering").

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- As for claim 46: Target objects are sorted into cluster of target objects that closest to the center of the cluster of target objects (page 322, par. 4, “Definitions” and par. 5, “Partitional Clustering”). A cluster profile comprising a set of words contained in the target profile of a selected object which have the highest relative frequency (par. 4.1, “Cluster digest”).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

REMARKS:

In response to the argument that Dedrick does not teach automatically generating target profile for target objects, the limitation is disclosed by Dedrick wherein a target profile of matched objects is automatically generated (8:64-9:14, 10:40-46) and the target profile comprises title and summary of the target object is generated from contents of target objects (13:36-41, 15:24-36).

In response to the argument that Dedrick does not teach automatically generate User target profile interest summary, the limitation is disclosed in 5:34-47, 6:53-63 wherein the User target profile interest summary is automatically generated based on monitored user activities.

In response to the argument that Dedrick does not teach one of the steps (f)(1) or (f)(2), Dedrick discloses transmitting a list of identified target objects to the user (step e1) and allowing the user to select and retrieve desired target objects (step e2). Thus there is a selection signal transmitted from the user terminal to the server (step f1), and a downloading of data from the server to the user terminal (step g). See 9:9-14, 13:39-46.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ba Huynh
Primary Examiner
AU 2179
10/27/07



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